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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200355
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Application Serial No. 78/575,442)	
Filed: February 25, 2005)	
Published: 2/22/2011, in the <i>Official Gazette</i>)	
For: SOUND MARK)	Opposition No. 91/200,355
)	
Motorola Mobility, Inc. and Motorola)	
Trademark Holdings, LLC,)	
)	
Opposers,)	
vs.)	
)	
Nextel Communications, Inc.)	
)	
Applicant.)	

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

**OPPOSERS' REPLY BRIEF IN SUPPORT OF THEIR MOTION FOR SUMMARY
JUDGMENT ON THE ISSUES OF RES JUDICATA AND COLLATERAL ESTOPPEL**

Pursuant to Fed. R. Civ. P. 56 and Trademark Rule 2.127(e)(1), Opposers Motorola Mobility, Inc. and Motorola Trademark Holdings, LLC (collectively, "Motorola") hereby submit their reply brief in support of their motion for summary judgment on preclusion.¹

I. Introduction

In its previous posture as a Chirp Tone "opposer," Nextel Communications, Inc. ("Nextel") challenged the Chirp Tone on invalidity grounds in two separate proceedings. Nextel prevailed against Motorola in both proceedings. With Motorola's Chirp Tone trademark applications covering "two-way radios" and "two-way radios and cellular telephones" out of its way, Nextel—as a Chirp Tone "applicant"—now seeks a clear path to registration of the Chirp Tone as a service mark for its "two-

¹ Motorola's summary judgment motion identified uncontested facts as required by T.B.M.P. § 528.01, which were supported by citations to the record. (Dkt. #12 at pp. 4-11.). Nextel's "Statement of Additional Facts" in its opposing brief (Dkt. #18 at pp. 2-6) consists primarily of citations to the *Nextel v. Motorola* holding, which do not require a response in this Reply Brief.

way radio services,” and others, identified in its Class 38 application. Nextel’s position, articulated in its opposition to Motorola’s summary judgment motion, is that the Board’s prior adjudications involving the identical mark for inextricably related goods have no preclusive effect and that Nextel should be entitled to register the Chirp Tone despite its prior successful invalidity challenges. In sum, Nextel seeks to relitigate the identical claims and issues, but this time from the perspective of an applicant defending the validity of the mark. A quote from a recent precedential Board decision succinctly undercuts Nextel’s attempt to circumvent the prior Chirp Tone holdings:

We must consider that “[c]ollateral estoppel, like the related doctrine of res judicata, has the dual purpose of protecting litigants from the burden of relitigating an identical issue with the same party or his privy and of promoting judicial economy by preventing needless litigation.”

In re Anderson, 101 U.S.P.Q.2d 1912, 1917 (T.T.A.B. 2012) (precedential).

As the Board noted in *In re Anderson*, the preclusion doctrine is “premised on principles of fairness.” *Id.* at 1917 (quoting *In re Freeman*, 30 F.3d 1459, 31 U.S.P.Q.2d 1444, 1467 (Fed. Cir. 1994)). Allowing Nextel to proceed with its Chirp Tone application under these circumstances would be directly contrary to the stated goals of sparing parties from duplicative litigation and promoting judicial economy. Motorola respectfully submits that summary judgment in its favor is appropriate.

II. The Parties Agree that there are no Genuine Factual Issues Regarding Preclusion

Despite its arguments against preclusion set forth in its opposing brief, Nextel’s co-pending cross-motion for summary judgment confirms that the following case-dispositive facts are undisputed: Nextel admits that certain services within its Class 38 application, including its “two-way radio services,” utilize the Chirp Tone as an operational alert tone in the normal course of the services. (Dkt. #11, Nextel SJ Mot. at 3, ¶¶ 2-3; Dkt. #10, Nextel Answer at ¶¶ 4, 17.) The Chirp Tone is emitted “to signal the ‘talk permit’ status of certain two-way radio communications....” (Dkt. #11, Nextel SJ Mot. at 3, ¶2.) Similarly, Nextel admits that additional services in its Class 38 application involve emission

of the Chirp Tone in the normal course of the services. (Dkt. #11, Nextel SJ Mot. at 3-4, ¶ 5 (listing services).)

Taken together, these admissions eviscerate any invalidity-based distinction Nextel seeks to draw between Motorola’s “communications goods” at issue in the prior preclusive decisions versus Nextel’s “communications services” at issue in this proceeding. The Chirp Tone is an operational alert tone for the goods *and* the inter-operative services. These admissions confirm that Motorola is entitled to summary judgment on preclusion grounds.

III. Nextel’s Admissions Regarding “Two-Way Radio Services” Preclude Its Class 38 Application in its Entirety

Although Nextel alleges that it has also used the Chirp Tone “in marketing and advertising Nextel services that do not use the Chirp sound in their normal operation,”² its admissions that the Chirp Tone is an operational alert tone for two-way radio services precludes its Class 38 Chirp Tone application in its entirety. It is well-settled that a finding of unregistrability as to one item in a class necessitates refusal as to the entire class. *See Electro-Coatings, Inc. v. Precision National Corporation*, 204 U.S.P.Q. 410, 420 (T.T.A.B. 1979). The Board has noted that a class must stand or fall together:

The rationale for the proposition that an application stands or falls and that the Board should not make distinctions between specific goods or services identified in one application (or one class of a multiple class application) seems to be that, on appeal or in an inter partes proceeding, we are adjudicating the registrability of the mark for the goods or services presented by the applicant. It is not for the Board to enter what is in effect an ex parte amendment to the application in order to salvage what may appear to be redeemable while discarding the other goods or services. The applicant must state what is desired, and on that application, either all will be granted or nothing. *The same rationale applies to an appeal or to an opposition (or cancellation) predicated on any of the statutory grounds available to a plaintiff.*

Id. at 420-21 (emphasis added).

² Dkt. #11, Nextel’s Opposition to Opposer’s Motion (“Opp. Br.”) at 5, ¶ 13.

This opposition involves Nextel’s Chirp Tone application as filed with the U.S.P.T.O. That application expressly identified “two-way radio services.” The Board will not re-write Nextel’s application at the opposition phase. *Id.* Invalidity-based preclusion arising out of “two-way radio services” dooms the entire class. “It is well-settled that if a term is generic to some of the goods or services listed in an application, ‘registration is properly refused.’” *In re Log Cabin Homes, Ltd.*, 52 U.S.P.Q.2d 1206, 1210 (T.T.A.B. 1999) (precedential) (citing *In re Analog Devices Inc.*, 6 U.S.P.Q.2d 1808, 1810 (T.T.A.B. 1988), *aff’d* 871 F.2d 1097, 10 U.S.P.Q.2d 1879 (Fed. Cir. 1989); *In re Brain Research Found.*, 171 U.S.P.Q. 825, 827 (T.T.A.B. 1971) (“Thus, if the term BRAIN RESEARCH FOUNDATION is incapable as functioning as a mark to identify the service of promoting research on the brain, it is also incapable of distinguishing those services that are incidental to and/or related thereto.”). As a result, Nextel exposed its Class 38 application—in its entirety—to claim and issue preclusion through its decisions to oppose Motorola’s “two-way radio” Chirp Tone applications on invalidity grounds.

Nextel’s Opposing Brief suggests that the Board should not apply preclusion against the Class as a whole because the Board only applied preclusion in *Nextel v. Motorola* against a subset of goods in Motorola’s application. However, Nextel fails to note that that the Board acknowledged that it was departing from its general rule against dividing a class in an *ex parte* or *inter partes* proceeding. “Normally, when an opposition is sustained with respect to certain goods or services for which registration is sought, it is generally proper to sustain the opposition with respect to the entire class of goods or services.” *Nextel Comm., Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d 1393, 1399 n.13 (T.T.A.B. 2009). The Board’s reluctance to apply preclusion against the class as a whole appears to have been based on the fact that neither claim nor issue preclusion were pleaded as grounds for opposition, and that the preclusive decision (911 Hz Chirp decision) was “relatively recent.” *Id.* at 1398; *see also id.* at

1399 n.13 (“Moreover, because issue preclusion was not brought up until the briefing, and the parties clearly view the telephones as presenting a separate and distinct issue, we will not allow the late assertion of issue preclusion to cause the whole class to fail.”) In the present case, Motorola has expressly pleaded claim and issue preclusion in its Notice of Opposition, and the preclusive *Nextel v. Motorola* decision is nearly three years old. There is no issue as to unfair surprise in the present case. As a result, there is no reason to refrain from applying invalidity preclusion against Nextel’s entire Class 38 application—not merely the “operational alert tone” two-way radio services.

IV. *Nextel v. Motorola* is Preclusive as to Nextel’s Inter-Operative Communications Services

Nextel’s attempt to circumvent claim and issue preclusion by noting that its Chirp Tone application covers *services*, while Motorola’s covered *goods*, is unconvincing. As noted in Motorola’s opening brief, a proposed mark that is invalid for the underlying goods is similarly invalid as to the related services. This doctrine is not merely limited to the retail re-sale of the goods, as Nextel suggests in its opposing brief. “[A] term which may not be the common name of a service but, rather, a common term or description for some *central or distinctive characteristic of a service*, may nevertheless be barred from exclusive appropriation as a service mark.” *In re Half Price Books, Records, Magazines, Inc.*, 225 U.S.P.Q. 219, 221 (T.T.A.B. 1984) (emphasis added); *see also In re Tires, Tires, Tires, Inc.*, 94 U.S.P.Q.2d 1153, 1157 (T.T.A.B. 2009) (precedential) (“A term that names the central focus or subject matter of the services is generic for the services themselves.”). As Nextel’s witness readily conceded in *Nextel v. Motorola*, the Chirp Tone was “inescapable” in operation among the general public at “workplaces” and “sporting events.” Nextel sought to capitalize upon the Motorola handset’s emission of the Chirp Tone as an operational alert tone, which alerted the user of the availability of the two-way radio service, by attempting to capture it as a mark. (Dkt. #13, Hodgson Decl. at Ex. 4 (Schweitzer Testimony at 55-56).) The Chirp Tone is clearly a “central or distinctive characteristic of [the] service.” *In re Half Price Books*, 225 U.S.P.Q. at 221. Thus, Nextel cannot

avoid operational alert tone invalidity preclusion by merely applying for “two-way radio services” as opposed to “retail sale of two-way radios.”³ Motorola is entitled to summary judgment.

V. Inherent Distinctiveness: Nextel’s Response to *Nextel* and *In Re Vertex* is Unpersuasive

In the event the Board declines to apply failure-to-function-as-a-mark preclusion against Class 38 as a whole, and instead opts to adjudicate Nextel’s applied-for services piecemeal, it must apply the *In re Vertex* rule because Nextel has admitted that numerous applied-for services utilize the Chirp Tone in the normal course of operation. (Dkt. #10, Nextel Answer ¶¶ 4, 17; Dkt. # 11, Nextel SJ Mot. at 3-4, ¶ 5.) As a result, Nextel must establish that the Chirp Tone has acquired distinctiveness. *Nextel*, 91 U.S.P.Q.2d at 1400-01 (citing *In re Vertex Group LLC*, 89 U.S.P.Q.2d 1694, 1700 (T.T.A.B. 2009)).

Nextel’s attempt to distinguish *Nextel* and *In re Vertex* is unpersuasive. Nextel argues that the decisions are inapplicable because they involved goods, not services. However, the *In re Vertex* rationale is applicable to the present application, which involves communications services inextricably tied to the previously-adjudicated “chirping” goods. See *Nextel*, 91 U.S.P.Q.2d at 1397 (finding that Nextel’s “Direct Connect” two-way radio service “allows subscribers to connect directly with each other using [Motorola’s] IDEN-equipped cellular telephone handsets.”). The *In re Vertex* panel noted that “certain types” of sound marks require a showing of acquired distinctiveness. *In re Vertex*, 89 U.S.P.Q.2d at 1700. Those include sound marks used in connection with products that emit the sound “in their normal course of operation.” *Id.* It is undisputed that the Chirp Tone is emitted as an operational alert tone in the normal course of at least some of Nextel’s applied-for services. (Dkt. #11, Nextel SJ Mot. at 3-4, 8, ¶¶ 2-3, 5, 19.) Thus, Nextel’s Class 38 communications services are without

³ Notably, there is a retail “resale” component to Nextel’s applied-for services. “Together, the parties have been in a long-standing business relationship, whereby [Motorola] manufactures phones and accessories ... which phones and accessories are sold to [Nextel] for resale to [Nextel’s] cellular service customers.” *Nextel*, 91 U.S.P.Q.2d at 1398.

doubt the type of services that emit the sound “in the normal course of operation.” *In re Vertex*, 89 U.S.P.Q.2d at 1700. As a result, Nextel’s attempt to distinguish *In re Vertex* is unavailing.

Nextel’s Opp. Br. asserts that Nextel “is not claiming inherent distinctiveness with respect to the services that emit the Chirp as part of their operation.” (Opp. Br. at 3, ¶ 1.) Regardless, it is undisputed that Nextel has submitted an acquired distinctiveness claim as to at least some of the applied-for services. Nextel’s acquired distinctiveness claim is a concession that the mark is not inherently distinctive. *In re A La Veille Russie, Inc.*, 60 U.S.P.Q.2d 1895, 1897 n.2 (T.T.A.B. 2001) (precedential). As noted above, Board precedent holds that the Class should be treated as a unitary whole. *See, e.g., Electro-Coatings*, 204 U.S.P.Q. at 420-21. Consequently, to the extent that the application survives preclusion based on failure to function as a mark, Nextel must prove acquired distinctiveness as to the entire Class.

VI. Nextel Fails to Rebut the “Concurrent Use” Acquired Distinctiveness Defect

The Board’s *Nextel v. Motorola* decision expressly held that the “most damaging” evidence defeating Motorola’s acquired distinctiveness claim was Nextel’s concurrent use of the Chirp Tone. *Nextel*, 91 U.S.P.Q.2d at 1408. As Motorola noted in its motion, this concurrent use problem applies equally to Nextel’s claim. If Motorola’s use was not substantially exclusive in light of Nextel’s use, it follows that Nextel’s use is similarly not substantially exclusive. Nextel curiously asserts that its use *is* substantially exclusive despite Motorola’s use, and that the Board’s precedential holding regarding the parties’ concurrent uses is irrelevant to its claim. (Opp. Br. at 12.) This is akin to arguing that although Nextel and Motorola share a room, Nextel is alone.

Nextel’s attempt to dismiss Motorola’s concurrent use argument as “illogical” (Opp. Br. at 12) or as involving a different set of “transactional facts” (*id.*) is unpersuasive. The “transactional facts” establishing that Motorola’s use was not substantially exclusive were Motorola’s use of the Chirp Tone in connection with its iDEN® handsets coupled with Nextel’s concurrent use of the Chirp Tone in

connection with its two-way radio service that “allows subscribers to connect directly with each other using [Motorola’s] IDEN-equipped cellular telephone handsets.” *Nextel*, 91 U.S.P.Q.2d at 1397. Of course, those are the same “transactional facts” at issue in this proceeding involving Nextel’s attempt to register the Chirp Tone in connection with those same two-way radio services. In Nextel’s own words, “[t]he limited evidence of Nextel’s use of the Chirp in the *Nextel v. Motorola* case was presented to rebut Motorola’s argument that it had exclusively used the mark and that the mark had acquired distinctiveness in connection with Motorola’s goods....” (Opp. Br. at 3, ¶ 3.) Although Nextel may seek to present “unlimited” evidence of its use of the Chirp Tone in this proceeding—as opposed to the so-called “limited” evidence it presented in *Nextel v. Motorola* for the purpose of defeating Motorola’s Section 2(f) claim—this has no bearing on the concurrent use issue. As the Board held, the parties’ concurrent use was the “most damaging” evidence in *Nextel v. Motorola*. Presentation of additional Section 2(f) evidence in the present case would be futile—the concurrent use defect remains in effect regardless of any additional evidence Nextel suggests it could present in a duplicative proceeding. Under the Board’s well-settled rule that a Class should be treated as a unitary whole, Motorola’s concurrent use of the Chirp Tone in connection with two-way radios defeats Nextel’s acquired distinctiveness claim as to two-way radio services *and* the remaining Class 38 services. *Electro-Coatings*, 204 U.S.P.Q. at 420-21.⁴

Moreover, Motorola’s concurrent use cannot be disregarded as “inconsequential or infringing.” (Opp. Br. at 13.) As the Board held in the preclusive *Nextel v. Motorola* decision, Motorola’s sales and

⁴ Nextel’s Opp. Br. asserts that Motorola “fails to explain” the Board’s observation in *Nextel v. Motorola* that a percentage of Nextel’s survey respondents identified Nextel and that the “Nextel” name was used in advertisements utilizing the Chirp Tone. (Opp. Br. at 16.) Motorola did not cite those passages from the opinion because they are not relevant to claim and issue preclusion. As explained in Motorola’s motion papers, the Board’s holding regarding the impact of the parties’ concurrent use is preclusive against Nextel’s acquired distinctiveness claim. Nextel’s surveys and advertising evidence do not overcome its concurrent use problem. See 15 U.S.C. § 1052(f); *Flowers Indus., Inc. v. Interstate Brands Corp.*, 5 U.S.P.Q.2d 1580, 1589 (T.T.A.B. 1987) (holding “descriptive” uses relevant to Section 2(f) analysis).

advertising for its Chirp Tone handsets were “substantial” and “impressive.” *Nextel*, 99 U.S.P.Q.2d at 1408. In light of those findings, Nextel cannot avoid preclusion by feebly asserting that it “intends to show that any ‘use’ of the Chirp by Motorola or others was inconsequential or infringing....” (Opp. Br. at 13.) Thus, Nextel’s attempt to distinguish established precedent holding that even non-trademark or descriptive uses defeat “substantially exclusive” use is unavailing. For example, Nextel argues that *Flowers Indus. Inc. v. Interstate Brands Corp.* 5 U.S.P.Q.2d 1580 (T.T.A.B. 1987) is distinguishable because the applicant’s use of the purported mark was deemed descriptive. (Opp. Br. at 13.) However, that does not capture the entire holding. After an analysis of various third parties’ descriptive non-trademark uses of HONEY WHEAT, the Board concluded that “such evidence overwhelmingly establishes...that applicant did not have substantially exclusive use of the designation in its specified area for the five years preceding the filing of its application.” *Id.* at 1588. This holding supports Motorola’s proposition that its non-trademark use of the Chirp Tone is relevant and not “inconsequential” under the Section 2(f) analysis.

Finally, Nextel asserts that preclusion is improper as to its acquired distinctiveness claim because circumstances have changed since the Board’s *Nextel v. Motorola* decision, and that it will seek to include “additional operative facts and later-occurring operative facts.” (Opp. Br. at 8.) This argument is unavailing for two reasons. First, any “new” acquired distinctiveness evidence would be futile because it would not circumvent the Board’s holding that the parties’ concurrent use of the Chirp Tone defeated Motorola’s acquired distinctiveness claim. There is no dispute that Motorola continues to use the Chirp Tone in connection with its two-way radios. (Dkt. #10, Nextel Answer at ¶¶ 4, 5, 25.) Of course, concurrent use cuts both ways—it similarly defeats Nextel’s claim. The parties’ concurrent use of the Chirp Tone in connection with two-way radio goods and services defeats Nextel’s acquired distinctiveness claim as to the entire Class. *Electro-Coatings*, 204 U.S.P.Q. at 420-21. Second,

Nextel's Opposing Brief does not cite to any pleadings—such as Nextel's answer and affirmative defense—where Nextel has alleged that circumstances have changed since the preclusive *Nextel v. Motorola* decision. However, if the Board permits Nextel to avoid preclusion as to any of the Class 38 services based on purportedly changed circumstances, Nextel would only be permitted to present acquired distinctiveness evidence coming into existence *after* the 2009 *Nextel v. Motorola* decision.

VII. Conclusion

In direct contrast to its prior position in *Nextel v. Motorola*, upheld by the Board, Nextel seeks to re-litigate these claims and issues to establish that: (1) the Chirp Tone functions as a mark; (2) is inherently distinctive; (3) has acquired distinctiveness, and is therefore registrable on the Principal Register. However, the Board has already held that the Chirp Tone does not function as a mark where it is used as an operational alert tone. It has further held that the Chirp Tone cannot be deemed inherently distinctive where it is emitted in the normal course of operation. Moreover, it has held that the Chirp Tone has not acquired distinctiveness due to concurrent use by the same two parties litigating this claim and issue today. Consequently, Motorola is entitled to judgment in its favor on all Class 38 services identified in Nextel's Chirp Tone service mark application.

Dated: April 2, 2012

Respectfully submitted,
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CERTIFICATE OF SERVICE

On April 2, 2012, I served the foregoing **OPPOSERS' REPLY BRIEF IN SUPPORT OF THEIR MOTION FOR SUMMARY JUDGMENT ON THE ISSUES OF RES JUDICATA AND COLLATERAL ESTOPPEL** on the parties in said action by depositing a true copy thereof with the United States Postal Service as first class mail, postage prepaid, at Chicago, Illinois, enclosed in a sealed envelope addressed to counsel of record for Applicant as follows:

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CHI:2638898.1